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UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Kendra L. Dunlap et al.

Confirmation No.: 5197

Application No.: 09/967,303

Examiner: B. Pesin

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Group Art Unit: 2174

Title: HOT LINKED HELP

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in *triplicate* is the Reply Brief with respect to the Examiner's Answer mailed on July 5, 2005. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Dated: August 31, 2005

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DELLAS G. FREDERIKSEN,
and DUSTIN C. ROSING

HP Docket No. 10006386-1

Serial No. : 09/967,303

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Group Art Unit 2174

For : HOT LINKED HELP

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REPLY BRIEF OF APPELLANTS

This Reply Brief is presented in opposition to the Examiner's answer dated July 5, 2005. Claims 1-23 are currently pending in the application. Applicants appeal the final rejection of claims 1-23.

ARGUMENT

A. The Legal Standard

As noted in applicants' April 7, 2005 Brief of Appellants, obviousness is a question of law based on (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (US 1966). "In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness

based upon the prior art." *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991).

B. Rejection of Claims 1-8, 14-15, and 21-23 under 35 U.S.C. § 103(a) as Being Unpatentable over the MS Word Screen Dumps is Inappropriate

The Examiner rejected claims 1-8, 14-15, and 21-23 as being obvious over MS Word as shown by the MS Word Screen Dumps, pages 1-5. Applicants assert that the Examiner has failed to establish the *prima facie* obviousness of claims 1-8, 14-15, and 21-23.

As understood from the MS Word Screen Dumps, pages 1-5 (Figs. 1-9), MS Word is a word-processing program having a drop down help menu. The help menu includes a "What's This?" tool, as shown in Figs. 2-4 of the MS Word Screen Dumps, and Figs. 1-5 of the Examiner's Answer dated July 5, 2005. Upon selection of the

“What’s This?” tool, an icon may be identified by passing a cursor thereover, and the function performed by that icon is identified in a pop-up window.

In addition to the “What’s This?” tool, the MS Word Screen Dumps also disclose a “Microsoft Word Help” tool (“MS Word Help” tool”). The “MS Word Help” tool provides a searchable database of topics for which help is available. Upon selection of the “MS Word Help” tool (as shown in Fig. 5), a window appears that includes a search field, a search results field, and a help window (as shown in Figs. 6-9). A user may enter a search term for which they would like help into the search field, such as the term “safeguard” shown in Fig. 6 of the MS Word Screen Dumps, or the term “format” shown in Figs. 7-9 of the MS Word Screen Dumps. Help topics related to the search term are then displayed in the search results field. A user may select a particular topic for which they would like help, such as “Troubleshoot borders,” or “Apply a language format to text in a document.” As shown in Fig. 6 of the MS Word Screen Dumps, a list of subtopics, related to the selected topic, may then be displayed in the help window, where each subtopic addresses a particular word processing task that a user is having trouble performing. Presumably, one or more of these subtopics may then be selected by the user based on the particular word processing task for which they would like to receive help. Selection of a topic from the search results field alternatively may provide some instructions on how to perform a particular word processing task, with links to additional instructions related to performing the word processing task, as shown in Figs. 7-9 of the MS Word Screen Dumps.

Independent claims 1, 6, 14, and 21 all recite a help mode that is selectable to provide for selection of an icon. Upon selection of an icon, a help window is displayed

having (1) an identification of the function associated with the icon, and (2) a link to instructions related to accomplishing the function associated with the icon.

In rejecting claims 1, 6, 14 and 21, the Examiner has expressly acknowledged that the “What’s This?” tool illustrated in the MS Word Screen Dumps does not include a link to instructions related to accomplishing the function associated with a selected icon. (See page 2, paragraph 3 of the Office action dated May 7, 2004; page 3, paragraph 2 of the Office action dated December 15, 2004; and page 4, paragraph 1 of the Examiner’s answer dated July 5, 2005). However, the Examiner asserts that it would be obvious “to modify the teachings of the MS Word ‘What’s This?’ tool to include a link to instructions related to a function and in response to user selection of the link displaying the instructions, as taught by the ‘MS Word Help’ tool.” (Page 3, paragraph 3 of the Office action dated December 15, 2004). The Examiner indicated that motivation for such a modification would be “to reduce the number of steps required to access help information.”

Applicants traverse these rejections, and assert that the Examiner has failed to establish a *prima facie* case of obviousness, because: (1) the MS Word Screen Dumps do not teach or suggest modifying the MS Word “What’s This?” tool to include a link to instructions related to accomplishing the function of an icon identifiable with the “What’s This?” tool, and (2) the Examiner has proposed a modification that changes the principle of operation of the “MS Word Help” tool.

The Examiner has not factually supported a *prima facie* conclusion of obviousness because the Examiner has not identified a proper teaching or suggestion to modify the “What’s This?” tool. The Examiner has improperly asserted that reducing the number of steps required to access help information is knowledge

generally available to one of ordinary skill in the art. However, as previously noted by applicants, the MS Word Screen Dumps do not demonstrate a motivation to reduce the number of steps required to access help information.

In response, the Examiner now indicates that in making this combination, he was not combining the entire "MS Word Help" tool with the "What's This?" tool. (See page 10, paragraph 1 of the Examiner's Answer dated July 5, 2005). Rather, the Examiner indicates that "[t]he only aspect of the Microsoft Word Help that the Examiner used in the combination were the links within the help files (i.e. Figure 7 and 8 [of the MS Word Screen Dumps])." The Examiner further argues that "[t]he use of links within help files is clearly a benefit to the user, because it reduces the number of steps in accessing help, and therefore there is a clear motivation to combine the references." *Id.* Applicants disagree.

Just because it is useful to provide links within help files, does not necessarily mean that it is obvious to provide a link to instructions related to the function associated with a selected icon. For example, the "MS Word Help" tool cited by the Examiner provides links between a wide variety of help topics. These help topics may (1) provide information about an icon; (2) discuss adding or removing an icon from the desktop; (3) describe the relationship between an icon and another icon or function; (4) provide instructions related to troubleshooting; and/or (5) provide instructions related to accomplishing the function of the icon.

In view of these various existing links, applicants query: if there is such a clear motivation to combine the "What's This" tool with links between help topics, then which links are obvious to combine with the "What's This?" tool, and why hasn't Microsoft made such a combination? The Examiner appears to be using applicants'

disclosure to find the motivation or suggestion to combine aspects of "MS Word Help" tool with the "What's This" tool. This is inappropriate because the motivation or suggestion to make the combination can not come from the disclosure of the applicant. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The proposed modification is therefore improper, and the rejection of claims 1, 6, 14 and 21 should be withdrawn.

The Examiner has also proposed a modification that changes the principle of operation of the "MS Word Help" tool. As previously noted, the Examiner proposes modifying the "MS Word Help" tool to have it automatically access a predetermined help topic. This is contrary to the intended operation of "MS Word Help." In response, the Examiner asserts that "the functionality of automatically accessing a predetermined help topic already exists in 'MS Word Help'." According to the Examiner, "[w]hen a user clicks on a link within that Microsoft Word Help new information about that specific (i.e. predetermined) topic is presented to the user (i.e. Figures 7-9 [of the MS Word Screen Dumps].)" (See page 10, paragraph 2 of the Examiner's answer filed July 5, 2005). The Examiner apparently ignores the fact that the "MS Word Help" tool necessarily requires some sort of user input to access the functionality cited by the Examiner. Neither the "MS Word Help" tool nor the "What's This?" tool provides access to the asserted functionality **by clicking on an icon**, a limitation that is specifically claimed in claims 1, 6, 14 and 21.

In fact, the only way to access the asserted functionality with either the "MS Word Help" tool or the "What's This?" tool is to use the "MS Word Help" tool to first enter a search query. The proposed modification thus changes the principle of operation of the "MS Word Help" tool and the "What's This?" tool, and the Examiner has therefore failed to support obviousness. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Further, the Examiner again appears to be using the applicants' disclosure as a template for modifying MS Word. This is inappropriate because the motivation or suggestion to make the proposed modification can not come from the disclosure of the applicant. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). The proposed modification is therefore improper, and the rejection of claims 1, 6, 14 and 21 should be withdrawn.

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending from that claim is also nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, claims 2-5 are nonobvious because they depend from nonobvious claim 1; claims 7-13 are nonobvious because they depend from claim 6; claims 15-20 are nonobvious because they depend from claim 14; and claims 22-23 are nonobvious because they depend from claim 21.

C. Rejection of Claims 9-13, and 16-20 under 35 U.S.C. § 103(a) as Being Unpatentable over the MS Word Screen Dumps in Combination with Fang is Inappropriate

The Examiner rejected claims 9-13 and 16-20 as being obvious over the MS Word Screen Dumps in combination with Fang. Applicants assert that the Examiner has failed to establish obviousness of claims 9-13 and 16-20.

In rejecting claims 9-13 and 16-20, the Examiner has asserted that "MS Word does not disclose the type of devices that can be used with this help system." (Page 6, paragraph 3 of the Office action dated December 15, 2004; page 6, paragraph 5 of the Examiner's answer dated July 5, 2005). The Examiner then asserted that:

"Fang teaches that the device running a help system is an auxiliary device (column 1, lines 17-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of MS Word to include running a help system on a plurality of auxiliary devices, as taught by Fang,

with the motivation to provide help on a plurality of devices that require user interaction.” *Id.*

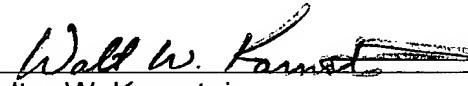
Applicants previously traversed this rejection, and asserted that the Examiner failed to establish obviousness, in part, because Fang does not disclose an auxiliary device that runs a help system. Rather, Fang discloses a Graphical User Interface (GUI) run on a computer for controlling an auxiliary device, where the GUI includes a help system. In response to this argument, the Examiner concurred that the GUI for the auxiliary devices in Fang is separate from the device, but asserts that applicants' claims do not recite that the GUI is a physical part of the device separate from the computer. Applicants submit that the user interface is, in fact, an element of the device itself, and thus is integral with the device. The rejection of claims 9-13 and 16-20 thus should be withdrawn.

D. Conclusion

The rejection of claims 1-23 is improper because claims 1-8, 14-15 and 21-23 are not obvious in view of the MS Word Screen Dumps (pages 1-5), and claims 9-13 and 16-20 are not obvious in view of the MS Word Screen Dumps in view of Fang. Accordingly, the rejection of all pending claims should be reversed.

Respectfully submitted,

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Heidi Dutro